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10/625,823	07/23/2003	Scott Goldthwaite	WS-102	7792

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215 GROVE ST.
NEWTON, MA 02466

EXAMINER

HANNON, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,823

Applicant(s)

GOLDTHWAITE ET AL.

Examiner

Christian A. Hannon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is response to applicant's response filed on 3/17/2006. Claims 1-15 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said wireless mobile phone" on the 4th-5th lines. There is insufficient antecedent basis for this limitation in the claim. It is believed by the examiner that the claim should read "said wireless mobile device" as that was introduced in the preamble of the claim, the claim will be examined as such.

Claims 2-15 are rejected under 35 U.S.C. 112, second paragraph, as they depend from claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 9 & 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Halpern (US 2004/0077372).

Regarding claim 1, Halpern teaches a wireless mobile device adapted to access a wireless network comprising a SIM card slot and a contactless smart card reader/writer module electrically connected to said wireless mobile phone via said SIM card slot and wherein said contactless smart card reader/writer module is adapted to receive and read information stored in a contactless smart card and transmit said information to an entity via said wireless network (Page 3, [0037], [0041], [0044]; Page 4, [0049]; Halpern). Halpern teaches that the data on a smart card can be updated, therefore it is inherent that data is read and written to the card thereby making Halpern's teachings read on the language of claim 1.

In regards to claim 2, Halpern teaches the wireless mobile device of claim 1, wherein said contactless smart card reader/writer module is further adapted to receive information from said entity via said network and transmit and write said information in said contactless smart card (Page 3, [0037],[0038]; Halpern).

Regarding claim 9, Halpern teaches the wireless mobile device of claim 1, further comprising an antenna for receiving and transmitting messages to and from said contactless smart card (Page 1, [0016]; Halpern).

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In regards to claim 13, Halpern teaches the wireless mobile device of claim 1 wherein said wireless mobile device is used for making financial transactions between a user and said entity with said contactless smart card over said network (Page 3, [0037], [0041], [0044]; Page 4, [0049]; Halpern).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern in view of Landman (WO 01/86599) and further in view of Althoff et al (US 2003/0018587), herein Althoff.

Regarding claim 3, Halpern teaches the mobile device of claim 1, however Halpern fails to teach wherein said information is selected from a group consisting of cardholder identification information, card identification information authentication information, smart card issuer information, financial institution information, digital goods, digital services and digital currency. Landman teaches wherein said information is selected from a group consisting of digital goods, digital services, and digital currency (Page 7, Lines 1-6; Landman). It would have been obvious to combine Halpern to include that said information is selected from a group consisting of digital goods, digital services, and digital

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currency, such as that taught by Landman, in order to broaden the data capable of being held on the smart card. It is noted that the phrase "token or other indicia of value" (Page 7, Line 2-3; Landman) is being interpreted to read on digital goods, services and currency, as these are all indicia's of value. However Halpern in view of Landman still fail to teach that said information is from the group consisting cardholder identification information, card identification information, authentication information, smart card issuer information and financial institution information. Althoff teaches that said information is from the group consisting cardholder identification information, card identification information, authentication information, smart card issuer information and financial institution information (Page 5, [0053]; Althoff). It would have been obvious to combine the teachings of Halpern in view of Landman to include that said information is from the group consisting cardholder identification information, card identification information, authentication information, smart card issuer information and financial institution information, such as that taught by Althoff in order to further broaden the data capable of being held on the smart card.

In regards to claim 4, Halpern in view of Landman and further in view of Althoff teach the wireless mobile device of claim 3, furthermore Landman teaches wherein said digital goods are selected from a group consisting of electronic cash electronic coupons electronic gift certificates electronic transit tokens, music, software movies and books. All of these aforementioned items intrinsically have value and are therefore obviously indicia's of value as taught by Landman (Page 7, Lines 1-6).

7. Claims 5, 6, 11 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern in view of Yaqub et al (2004/0180657), herein Yaqub.

In regards to claim 5, Halpern teaches the wireless mobile device of claim 1, in addition Halpern also teaches a memory (Figure 1, MEMORY; Halpern), a CPU (Figure 3, CPU1; Halpern), a SIM card slot (Page 3, [0040]; Halpern) and a first application program associated with said memory and said CPU and being adapted to receive and transmit instructions from said contactless smart card module to said wireless mobile phone and the reverse (Figure 3, BR1; Halpern). However Halpern fails to teach a SIM card connected to said SIM card slot said SIM card authenticating said wireless mobile device to said wireless network. Yaqub teaches a SIM card connected to said SIM card slot said SIM card authenticating said wireless mobile device to said wireless network (Page 1, [0002]; Yaqub). It would have been obvious to combine Halpern to include a SIM card connected to said SIM card slot said SIM card authenticating said wireless mobile device to said wireless network, such as that taught by Yaqub, in order to validate that the SIM card slot worked.

With respect to claim 6, Halpern in view of Yaqub teach the wireless mobile device of claim 5, furthermore Halpern teaches a second application program associated with said memory and said CPU and being adapted to route and transmit data and information among said wireless mobile phone, said smart card module, and other interfaces connected to said CPU (Page 3, [0041]; Figure 3, IN; Halpern).

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Regarding claim 11, Halpern teaches the wireless device of claim 1, however Halpern does not explicitly teach the various types of wireless networks the wireless communication device could work on. Yaqub teaches that said wireless network is selected from a group consisting of a WWAN, WLAN, a private network, and a PAN (Page 2, [0025]; Yaqub). It would have been obvious to combine Halpern to include that said wireless network is selected from a group consisting of a WWAN, WLAN, a private network, and a PAN, such as that taught by Yaqub, in order to provide multiple access to multiple networks based on a corresponding SIM card.

In regards to claim 12, Halpern in view of Yaqub teaches the wireless mobile device of claim 11. Furthermore Yaqub teaches wherein said WWAN is selected from a group consisting of a GSM, CDMA, CDMA 2000 and WCDMA (Page 2, [0025]; Yaqub).

8. Claims 7 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern in view of Yaqub as applied to claims 5, 6, 11 & 12 above, and further in view of Althoff.

In regards to claim 7, Halpern in view of Yaqub teaches the wireless mobile device of claim 6, furthermore Halpern teaches a smart card interface (Page 3, [0040]; Halpern) and Yaqub teaches an infrared transceiver interface (Page 2, [0021]; Yaqub), however Halpern in view of Yaqub fail to teach wherein said other interfaces are selected from a group consisting of serial communication interfaces and infrared transceiver interfaces. However Yaqub

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teaches a magnetic stripe reader interface (Page 5, [0048]; Althoff), which obvious to one of ordinary skill in the art could be constructed using serial communication techniques. It would have been obvious to provide Halpern and Yaqub with a magnetic stripe reader interface, such as that taught by Yaqub, in order to provide a most convenient interface to an end user.

Regarding claim 8, Halpern and Yaqub teach the wireless mobile device of claim 6, furthermore with the addition of the Althoff reference teach that the group consisting of said CPU, said SIM card, an external SIM card, said contactless smart card, and an external card, all of which have been previously taught within the action, obviously all have a memory and therefore obvious of one of ordinary skill in the art have the capacity to store data, be it a first and second application, or any other data.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern in view of Pathmasuntharan et al (US 6,955,299), herein Path.

With respect to claim 14, Halpern and Path. teach the wireless mobile device of claim 13, furthermore Path. teaches that said financial transactions between said user and said entity are face-to-face (Column 1, Lines 34-50; Path.). The transactions described in Path. are all obviously everyday face-to-face transactions.

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10. Claims 10 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern in view of Path. and further in view of Nemirofsky et al (5,880,769), herein Nemi.

In regards to claim 10, Halpern teaches the wireless mobile device of claim 1, also Halpern teaches wherein said wireless mobile device is selected from a group consisting of a mobile phone, a personal digital assistant, a wireless laptop computer & a personal computer (Page 1, [0016], [0017]; Halpern).

However Halpern fails to teach where the wireless mobile device is selected from the group of a pager and a television remote. Path. teaches the use of the wireless mobile device as a pager (Column 6, Lines 50-53; Path.). It would have been obvious to combine Halpern to include the pager taught by Path. in order to allow for end users to only have to carry a small pager, thereby unburdening the end user of unnecessary weight or heavier peripherals. However Halpern in light of Path. still does not teach the wireless mobile device consisting of a television remote control. Nemi. teaches the use of a television remote control as a wireless mobile device (Column 7, Lines 62-66; Nemi.). It would have been obvious to combine Halpern and Path. with the teachings of Nemi. in order to implement an ordinary household object to provide for the wireless mobile device. Furthermore combinations of the above are obvious and can readily be found in the state of the art.

Regarding claim 15, Halpern in view of Path. teach the wireless mobile device of claim 13, however Halpern and Path. fail to explicitly teach that said financial transactions between said user and said entity are remote. However,

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Nemi. teaches that said financial transactions between said user and said entity are remote (Column 2, Lines 5-10; Nemi.). It would have been obvious to combine the teachings of Halpern and Path, to include remote financial transactions such as that taught by Nemi. due to the nature of a wireless communication device, obviously suggests remoteness.

Response to Arguments

11. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morgan et al (US 2004/0058705) disclose a secure point of sale cellular telephone docking module system.

Teicher (US 2004/0242208) discloses a payment system and method for mobile communication services.

Song et al (US 2002/0047045) disclose an embedded smart card reader for handheld-computing devices.

Zalewski et al (US 6,771,981) disclose an electronic device cover with embedded radio frequency transponder and method of using the same.

Luu (US 2003/0213849) discloses a contactless transaction card and adapter therefor.

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13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian A. Hannon whose telephone number is (571) 272-7385. The examiner can normally be reached on Mon. - Fri. 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christian A. Hannon
May 25, 2006



QUOCHIEN B. VUONG
PRIMARY EXAMINER